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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,827	10/07/2003	Bishwajit Nag	BEX1P004	6590
22434	7590	04/11/2005	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			CORDERO GARCIA, MARCELA M	
			ART UNIT	PAPER NUMBER
			1654	
DATE MAILED: 04/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/681,827

Applicant(s)

NAG ET AL.

Examiner

Marcela M Cordero Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 8, 9, 15-21 and 25-26 is/are pending in the application.
- 4a) Of the above claim(s) 5, 10-14 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8, 9, 15-21, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

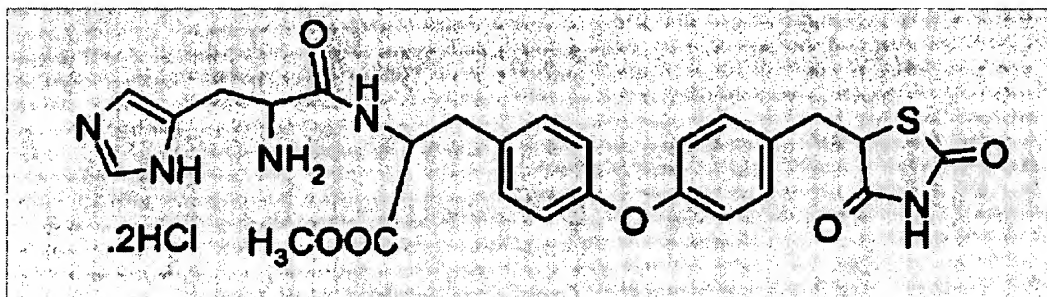
**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/04 and 03/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Applicants' response to the restriction requirement and election of species in February 22, 2004 is acknowledged.

Applicants elected without traverse Group I, claims 1-21, 25 and 26. In addition applicants elected without traverse the species disclosed on page 32, lines 3-4, as shown below (Claims 1-4, 6, 8, 9, 15-21, 25 and 26 readable thereon):



Claims 1-4, 6, 8, 9, 15-21, 25 and 26 are presented for examination on the merits.

***Claim Objections***

Claims 25 and 26 are objected to under 37 CFR 1.75(c) as being in improper form because they appear in the form of a multiple dependent claim "as defined in any of the claims 1 to 15". See MPEP § 608.01(n).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6, 8, 9, 15-21, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rendered vague and indefinite by the phrase in line 4: "their derivatives, their analogs" because it is unclear what structurally constitutes a derivative and/or an analog of a formula I compound, and therefore the terms fail to define the metes and bounds of the invention

Claim 1 is also rendered vague and indefinite by the phrase in line 16: "an amino acid or a derivative thereof" because it is unclear what structurally constitutes a derivative of an amino acid is and therefore the claim fails to define the metes and bounds of the invention.

Claim 3 is rendered vague and indefinite by the phrase in line 4: "or their derivatives" for the reasons set forth above.

Claims 6-8 are rendered vague and indefinite by the phrase in lines 1-2: "or a derivative thereof" for the reasons set forth above.

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Claims 16-21 are rendered vague and indefinite by the phrase "their derivatives, their analogs" in line 4, and by the phrase "a derivative thereof" in line 15, for the reasons set forth above.

All other claims that depend directly or indirectly from rejected claims and are, therefore, also rejected under USC 112, second paragraph for the reasons set forth above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 6, 8, 9, 15, 16, 18, 19, 20, 21, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Nag et al. (US 6,794,401, reference A16 in IDS of October 5, 2004).

Nag et al. teach derivatives or analogs of the dipeptide phenyl ethers and/or processes of preparation of the instantly claimed formula (I). (See, e.g., column 51, Example I).

Therefore, the reference is deemed to anticipate the instant claims above, as drafted.

Claims 1-4, 6, 8, 9, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujita et al. (US 6,562,849).

Fujita et al. teach derivatives or analogs of the dipeptide phenyl ethers of the instantly claimed formula (I). (See, e.g., columns 65, 66, 77 and 78).

Therefore, the reference is deemed to anticipate the instant claims above, as drafted.

Claims 1-4, 6, 8, 9, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sohda et al. (US 6,552,058, reference A7 in IDS of October 5, 2004).

Sohda et al. teach derivatives or analogs of the dipeptide phenyl ethers of the instantly claimed formula (I). (See, e.g., columns 1-4).

Therefore, the reference is deemed to anticipate the instant claims above, as drafted.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6, 8, 9, 15, 16, 17, 18, 19, 20, 21, 25 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Nag et al. (US 6,794,401).

Nag et al. (US 6,794,401) teach derivatives or analogs and/or processes of preparation of the instantly claimed dipeptide phenyl ethers of formula (I). [See, e.g., column 51, Example I and claims].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust particular conventional working conditions within such synthetic method (e.g., using different paths / protecting groups in order to optimize the yield) based upon the overall beneficial teachings provided by Nag et al. These types of adjustments are deemed merely a matter of judicious selection and routine optimization that is well within the purview of the skilled artisan.

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Thus, the invention as a whole is prima facie obvious over the reference, especially in the absence of evidence to the contrary.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 8, 9, 15, 16, 18, 19, 20, 21 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14, 16-17, 18, 19, 20, 21, 22 and 23 of U.S. Patent No. 6,794,401 (reference A16 in IDS of October 5, 2004). Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds and methods of preparation of derivatives or analogs of formula (i) claimed in the instant Application overlap with those claimed in US No. 6,794,401.



***Information Disclosure Statement***

The information disclosure statements (IDSs) were submitted on October 5, 2004 and March 11, 2005, were filed after the mailing date of the application on October 7, 2003. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements (IDSs) have been considered by the examiner.

***Conclusion***

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcela M Cordero Garcia whose telephone number is (571) 272-2939. The examiner can normally be reached on M-Th 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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MMCG 03/05



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PRIMARY EXAMINER